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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|-------------------------------|
| 10/743,825 | 12/24/2003 | Akira Kinno | 247194US8X | 1141 |
| 22850 | 7590 | 10/13/2006 | | |
| C. IRVIN MCCLELLAND OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314 | | | | EXAMINER RIES, LAURIE ANNE |
| | | | | ART UNIT 2176 |
| | | | | PAPER NUMBER |

DATE MAILED: 10/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/743,825 | KINNO ET AL. | |
| | Examiner | Art Unit | |
| | Laurie Ries | 2176 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 17 August 2006.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-9 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-9 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 24 December 2003 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>6/8/05</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Amendment, filed 17 August 2006, to the Original Application, filed 24 December 2003.
2. The rejection of claim 5 under 35 U.S.C. 101 has been withdrawn as necessitated by amendment.
3. Claims 1-6 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Callahan (U.S. Publication 2002/0157023 A1) in view of Sheynblat (U.S. Patent 6,677,894 B2).
4. Claims 1-9 are pending. Claims 7-9 are newly added claims. Claims 1, 5, 6, 7, 8, and 9 are independent claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Callahan (U.S. Publication 2002/0157023 A1) in view of Sheynblat (U.S. Patent 6,677,894 B2).

As per independent claims 1 and 5-9, Callahan discloses an apparatus, program and method for converting a structured document including acquiring distribution rule information sent from a remote source when data contents are sent to a distribution means (See Callahan, Figure 3, elements 308a, b, and c), including rules as to who may receive and view a particular file, which describe contents rules and receiver side situation information, such as a patient's assigned physician, etc (See Callahan, Page 3, paragraphs 0052-0054, and Page 5, paragraphs 0071-0072).

Callahan also discloses generating conversion rule information for converting structured documents with described content where the converting rules are based on the receiver side situation information previously acquired (See Callahan, Page 6, paragraphs 0074-0075 and paragraphs 0081-0082).

Callahan also discloses converting the structured documents on the basis of the conversion rule information (See Callahan, Page 6, paragraph 0083) and storing the structured documents in a computer readable memory for subsequent retrieval (See Callahan, Figure 3, element 306).

Callahan does not disclose expressly that the converting rules are based upon distribution rule information in addition to the receiver side situation information. Sheynblat discloses that information may be sent based on distribution rules that include a user's location and the like (See Sheynblat, Column 20, lines 15-26).

Callahan and Sheynblat are analogous art because they are from the same field of endeavor of distributing information across a network.

At the time of the invention it would have been obvious to one of ordinary skill in the art to include the distribution rule information of Sheynblat in the generation of converting rules of Callahan. The motivation for this would have been to allow for the inclusion of targeted marketing, billing, etc, based on a customer's location (See Sheynblat, Column 20, lines 26-31). Therefore it would have been obvious to combine Sheynblat with Callahan for the benefit of allowing for the inclusion of targeted marketing, billing, etc, based on a customer's location to obtain the invention as specified in claims 1, 5 and 6.

As per dependent claim 2, Callahan and Sheynblat disclose the limitations of claim 1 as described above. Callahan also discloses that the generating includes extracting evaluation objects of the conditions includes in distribution rules and extracting receiver side situation information (See Callahan, Page 6, paragraph 0081). Callahan also discloses evaluating the conditions on the basis of the receiver side situation information extracted by the second extraction and on the basis of the results of the evaluation on the conversion rules information (See Callahan, Page 6, paragraph 0081).

As per dependent claim 3, Callahan and Sheynblat disclose the limitations of claim 2 as described above. Callahan also discloses that when the evaluation is a negative evaluation, such as excluding some physicians from viewing a patient's medical test record, generating the conversion rule information to delete objects

corresponding to the conditions under which the evaluation has been performed from the structured document (See Callahan, Page 6, paragraph 0082).

As per dependent claim 4, Callahan and Sheynblat disclose the limitations of claim 2 as described above. Callahan also discloses a memory for storing the conversion rule information as created in claim 2 (See Callahan, Page 6, paragraph 0073, and Figure 1, element 106).

Response to Arguments

6. Applicant's arguments filed 17 August 2006 have been fully considered but they are not persuasive.

Applicant argues on Page 10 of the Instant Amendment that Callahan in combination with Sheynblat fails to teach transmitting and receiving distribution rule information and receiver side situation information. The Office respectfully disagrees. Callahan teaches converting structured documents on the basis of conversion rule information, such as role attributes defined in an XSLT stylesheet (See Callahan, Page 6, paragraph 0083). Sheynblat teaches sending information on the basis of distribution rules, such as a user's location and the like (See Sheynblat, Column 20, lines 15-26). At the time of the invention it would have been obvious to one of ordinary skill in the art to include the distribution rule information of Sheynblat in the generation of converting rules of Callahan. The motivation for doing so would have been to allow for the inclusion

of targeted marketing, billing, etc, based on a customer's location (See Sheynblat, Column 20, lines 26-31).

In response to applicant's argument that incorporating the distribution rule information of Sheynblat with the system and method disclosed by Callahan, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Applicant argues on Page 12 of the Instant Amendment that Callahan in combination with Sheynblat fails to teach evaluating the conditions on the basis of the receiver side situation extracted by the second extraction. The Office respectfully disagrees. Callahan teaches evaluating conditions based on receiver side situation information extracted by the second extraction, such as rules concerning who should see the distributed contents.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 2176

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurie Ries whose telephone number is (571) 272-4095. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (571) 272-4136.
9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LR

William S. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER